



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,677	08/15/2001	Martin Khang Nguyen	Nguyen.M-01	3351

22197 7590 08/11/2005

GENE SCOTT; PATENT LAW & VENTURE GROUP  
3140 RED HILL AVENUE  
SUITE 150  
COSTA MESA, CA 92626-3440

EXAMINER
----------

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Notice of Abandonment

Application No.

09/931,677

Examiner

Jean Janvier

Applicant(s)

NGUYEN, MARTIN KHANG

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 27 January 2005.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

See Continuation Sheet

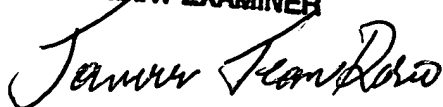


Jean Janvier  
Examiner  
Art Unit: 3622

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Item 7 - Other reasons for holding abandonment: The Examiner had called the Attorney of record regarding the status of the current Application and spoke with Mr. Scott, the Attorney. Mr. Scott had provided the Examiner with a phone number related to a new Attorney, Mr. Nguyen, who appears to be the Applicant as well. Upon contacting Mr. Nguyen, the Examiner had learned that he had received no correspondence from the Office. Upon examining the associated records, it appears that a change of correspondence was recorded in our database on 08/17/2004. However, it was incomplete or defective. Subsequently, the Office had mailed out a correspondence with instructions to correct the change of address and/or Power of Attorney to Mr. Gene Scott who is still the Attorney of record. Since no formal correction was made or no change in the Power of Attorney was received by PTO, we continue sending all correspondence or mailings to Mr. Scott including the Office Action, which was successfully mailed out to Mr. Scott's Office since he is still the Attorney of record and not Mr. Nguyen. To this end, the Office has fulfilled its responsibility towards the deint and it is Mr. Scott's duty or responsibility to forward all received correspondence to Mr. Nguyen until a successful Change in the Power of Attorney takes place. And sine the time to reply to the Office Action has expired, the Examiner has decided to abandon the Instant Application under 1.134-1.135 and the Applicant can revive the case under 1.137 for unintentional abandonment accordingly.

JEAN D. JANVIER  
PRIMARY EXAMINER



Office Response

12/22/04



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	PATENT NUMBER	GROUP ART UNIT	FILE WRAPPER LOCATION
09/931,677		3622	06B0

### Change of Address/Power of Attorney

The following fields have been set to Customer Number 22197 on

- Correspondence Address
- Maintenance Fee Address

The address of record for Customer Number 22197 is:

GENE SCOTT; PATENT LAW & VENTURE GROUP  
3140 RED HILL AVENUE  
SUITE 150  
COSTA MESA, CA 92626-3440

The Practitioners of record for Customer Number 22197 are:

### PTO INSTRUCTIONS:

Please take the following action when the correspondence address has been changed to a customer number:

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WUR 6/1/2003

CHANGE OF CORRESPONDENCE ADDRESS Address	
Application No.	09/931,677
Filing Date	August 15, 2001
First Named Inventor	Martin Khang Nguyen
Group Art Unit	3622
Examiner Name	
Attorney Docket Number	6841P001

Address to:  
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Alexandria, VA 22313-1450

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AUG 17 2004

OFFICIAL

Please change the Correspondence Address for the above-identified application to:

☒ Customer Number **08791**  
Type Customer Number here

OR

<input type="checkbox"/> Firm or Individual Name					
Address					
Address					
City		State		ZIP	
Country					
Telephone		Fax			

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124)

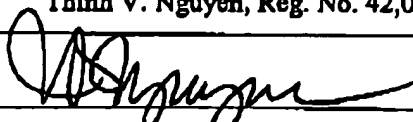
I am the:

- ☐ Applicant/Inventor.
- ☐ Assignee of record of the entire interest.  
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)
- ☒ Attorney or Agent of record. Registration Number 42,034.

Typed or Printed  
Name

Thinh V. Nguyen, Reg. No. 42,034

Signature



Date

August 17, 2004

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of \_\_\_\_\_ forms are submitted.

Based on PTO/SB/122 (09-03) as modified by Blakely, Sokoloff, Taylor & Zafman (w/02/10/2004,  
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

MARTIN KHANG NGUYEN

Application No.: 09/931,677

Filed: August 15, 2001

For: **DISCOUNT PURCHASE BUSINESS  
METHOD**

Art Group: 3622

Examiner:

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AUG 17 2004

OFFICIAL

STATUS INQUIRY

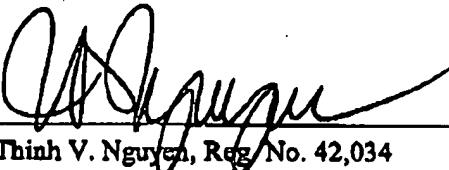
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

The above-captioned application, an amendment thereto, or an Appeal Brief was filed more than 18 months ago and no substantive Office Action has issued to date. Please provide the current status of the application and an indication of when the next Action is expected to issue.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

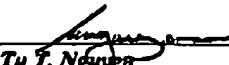
Date: August 17, 2004

  
Thinh V. Nguyen, Reg. No. 42,034

12400 Wilshire Boulevard, 7th Floor  
Los Angeles, CA 90025  
Telephone: (714) 557-3800

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile on the date shown below to the United States Patent and Trademark Office.

  
Tu T. Nguyen

08/17/04

Date

AUG. 17. 2004 5:01PM

BST&Z - CM

NO. 2968 P. 1

TO: USPTO

# BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

TELEPHONE: (714) 557-3800

INTELLECTUAL PROPERTY LAW  
12400 WILSHIRE BOULEVARD, 7TH FLOOR  
LOS ANGELES, CA 90025

FACSIMILE: (714) 557-3800

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AUG 17 2004

## FACSIMILE COVER SHEET

# OFFICIAL

Deliver to: USPTO

Art Group: 3622

Facsimile No.: 703.872.9306

Date: August 17, 2004

From: Thinh V. Nguyen, Reg. No. 42,034

Our Docket No.: 6841P001

Number of pages 6 including this sheet.

Application No.: 09/931,677

Filing Date: 8/15/2001

Docket Due Date(s): \_\_\_\_\_

Enclosed are the following documents:

- |   |   |
|---|---|
| <input type="checkbox"/> Amendment: _____ ( _____ pgs)  | <input type="checkbox"/> Issue Fee Transmittal                                    |
| <input type="checkbox"/> Appeal Brief (in triplicate) ( _____ pgs)                                    | <input type="checkbox"/> Notice of Appeal   |
| <input type="checkbox"/> Application: _____<br>( _____ pgs) w/cover & abstract                        | <input type="checkbox"/> Petition for: _____                                      |
| <input type="checkbox"/> Assignment & Cover Sheet ( _____ pgs)  | <input type="checkbox"/> Request for Continued Examination (RCE)                  |
| <input type="checkbox"/> Certificate of _____   | <input type="checkbox"/> Reply Brief ( _____ pgs)                                 |
| <input type="checkbox"/> Continued Prosecution Application (CPA)                                      | <input type="checkbox"/> Request & Certification Under 35 USC 122(b)(2)(B)(i)     |
| <input type="checkbox"/> Declaration & POA ( _____ pgs)   | <input type="checkbox"/> Request to Rescind Previous Nonpublication Request       |
| <input type="checkbox"/> Drawings: _____ sheets, _____ figures  | <input type="checkbox"/> Response to Notice of Missing Parts & Formalities Letter |
| <input type="checkbox"/> Extension of Time: _____   | <input type="checkbox"/> Response to Written Opinion ( _____ pgs)                 |
| <input checked="" type="checkbox"/> Fee Transmittal (in duplicate)                                    | <input type="checkbox"/> Terminal Disclaimer                                      |
| <input type="checkbox"/> IDS & PTO/BB/08 ( _____ pgs)   | <input type="checkbox"/> Transmittal of Publication Fee Due                       |
| <input checked="" type="checkbox"/> Other - Change of Correspondence Address<br><u>Status Request</u> | <input checked="" type="checkbox"/> Transmittal Letter                            |

### CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.84)

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Tu T. Nguyen

08/17/2004

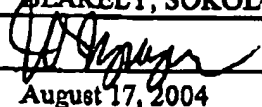
Date


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If you do not receive all the pages, or if there is any difficulty in receiving, please call: (714) 557-3800 and ask for Tu T. Nguyen.

<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>		Application No.	09/931,677
		Filing Date	August 15, 2001
		First Named Inventor	Martin Khang Nguyen
		Art Unit	3622
		Examiner Name	
Total Number of Pages in This Submission	5	Attorney Docket Number	6841P001

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavit/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input checked="" type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 5px;">         - Change of correspondence address       </div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Thinh V. Nguyen, Reg. No. 42,034 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	August 17, 2004

CERTIFICATE OF MAILING/TRANSMISSION			
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Typed or printed name	Tu T. Nguyen		
Signature		Date	August 17, 2004

Based on PTO/SB/21 (04-04) as modified by Blakely, Sokoloff, Taylor & Zafman (m/s) 08/04/2004.  
 SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

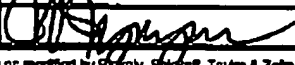


<b>FEE TRANSMITTAL for FY 2004</b>		<i>Complete if Known</i>	
<small>Effective 01/01/2004. Patent fees are subject to annual revision.</small>		Application Number	09/931,677
		Filing Date	August 15, 2001
		First Named Inventor	Martin Khang Nguyen
		Examiner Name	
		Art Unit	3622
		Attorney Docket No.	6841P001
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.			
TOTAL AMOUNT OF PAYMENT (\$)			

METHOD OF PAYMENT (check all that apply)		FEE CALCULATION (continued)																																															
<input type="checkbox"/> Check <input type="checkbox"/> Credit card <input type="checkbox"/> Money Order <input type="checkbox"/> Other <input type="checkbox"/> None <input checked="" type="checkbox"/> Deposit Account		<b>3. ADDITIONAL FEES</b>																																															
Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP																																																	
The Commissioner is authorized to: (check all that apply) <input type="checkbox"/> Charge fee(s) indicated below <input checked="" type="checkbox"/> Credit any overpayments <input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fees as required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20. <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.																																																	
<b>FEE CALCULATION</b>																																																	
<b>1. BASIC FILING FEE</b> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th rowspan="2">Fee Description</th> <th rowspan="2">Fee Paid</th> </tr> <tr> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> </tr> </thead> <tbody> <tr> <td>1001</td> <td>770</td> <td>2001</td> <td>385</td> <td>Utility filing fee</td> <td></td> </tr> <tr> <td>1002</td> <td>340</td> <td>2002</td> <td>170</td> <td>Design filing fee</td> <td></td> </tr> <tr> <td>1003</td> <td>630</td> <td>2003</td> <td>285</td> <td>Plant filing fee</td> <td></td> </tr> <tr> <td>1004</td> <td>770</td> <td>2004</td> <td>385</td> <td>Reissue filing fee</td> <td></td> </tr> <tr> <td>1005</td> <td>160</td> <td>2005</td> <td>80</td> <td>Provisional filing fee</td> <td></td> </tr> <tr> <td colspan="5" style="text-align: right;">SUBTOTAL (1)</td> <td>(5)</td> </tr> </tbody> </table>		Large Entity		Small Entity		Fee Description	Fee Paid	Fee Code	Fee (\$)	Fee Code	Fee (\$)	1001	770	2001	385	Utility filing fee		1002	340	2002	170	Design filing fee		1003	630	2003	285	Plant filing fee		1004	770	2004	385	Reissue filing fee		1005	160	2005	80	Provisional filing fee		SUBTOTAL (1)					(5)		
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<b>2. EXTRA CLAIM FEES</b> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th rowspan="2">Fee Description</th> <th rowspan="2">Fee Paid</th> </tr> <tr> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> </tr> </thead> <tbody> <tr> <td>1202</td> <td>18</td> <td>2202</td> <td>9</td> <td>Claims in excess of 20</td> <td></td> </tr> <tr> <td>1201</td> <td>88</td> <td>2201</td> <td>43</td> <td>Independent claims in excess of 8</td> <td></td> </tr> <tr> <td>1203</td> <td>290</td> <td>2203</td> <td>145</td> <td>Multiple Dependent claim, if not paid</td> <td></td> </tr> <tr> <td>1204</td> <td>88</td> <td>2204</td> <td>43</td> <td>**Release independent claims over original patent</td> <td></td> </tr> <tr> <td>1206</td> <td>18</td> <td>2206</td> <td>9</td> <td>**Release claims in excess of 20 and over original patent</td> <td></td> </tr> <tr> <td colspan="5" style="text-align: right;">SUBTOTAL (2)</td> <td>(5)</td> </tr> </tbody> </table>		Large Entity		Small Entity		Fee Description	Fee Paid	Fee Code	Fee (\$)	Fee Code	Fee (\$)	1202	18	2202	9	Claims in excess of 20		1201	88	2201	43	Independent claims in excess of 8		1203	290	2203	145	Multiple Dependent claim, if not paid		1204	88	2204	43	**Release independent claims over original patent		1206	18	2206	9	**Release claims in excess of 20 and over original patent		SUBTOTAL (2)					(5)		
Large Entity		Small Entity		Fee Description	Fee Paid																																												
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*or number previously paid, if greater, For Reissuance, see below																																																	
		SUBTOTAL (3) (5)																																															

SUBMITTED BY		<i>Complete if applicable</i>	
Name (Print/Type)	Thanh V. Nguyen	Registration No. (Attorney/Agent)	42,034
Signature		Telephone	(714) 557-3800
		Date	08/17/04

Based on PTO/SB/17 (10-03) as modified by Blakely, Sokoloff, Taylor & Zafman (M) 02/10/2004.  
 SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22315-1450



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United States Patent and Trademark Office  
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09/931,677	08/15/2001	Martin Khang Nguyen	Nguyen.M-01	3351

22197 7590 01/27/2005

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3140 RED HILL AVENUE  
SUITE 150  
COSTA MESA, CA 92626-3440

EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/931,677	NGUYEN, MARTIN KHANG	
	Examiner	Art Unit	
	Jean D Janvier	3622	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Specification***

The title of the invention, under 37 CFR 1.72, should be descriptive, brief and technically accurate and should be placed on the first page of the specification.

### ***Status of the claims***

Claims 1-3 are now pending in the Instant Application.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the

term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject

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matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was

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already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Here, the steps as recited in the claims pertain to a manual process and therefore, the claims do not fall within the technological art. To this end, a relevant device or hardware, such as a computer system, a computer database, a data communication, computer network, a card reader, the Internet and so and so forth should be used to implement the steps or process recited in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski, WO 98/19229.

As per claims 1-3, Fajkowski discloses a system for providing a coupon card or value

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card (wallet card), from a coupon card issuer, containing one or more coupons or multiple coupons on a single product or service to a customer, who uses the coupon card for redeeming one or more stored coupons during a transaction at a POS or retail establishment, wherein, upon inserting the customer's unique coupon card 1 into the retail establishment periphery device 100 and detecting the presence of at least one stored coupon associated with a product in the customer's order (when a product UPC code stored on the coupon card matches a product UPC code in the customer's order), a price reduction is applied to the customer's transaction and the retail establishment is subsequently credited or reimbursed for honoring or redeeming the at least one coupon retrieved from the customer's coupon card 1 (See abstract; page 4: 24 to page 9: 7). Fajkowski further discloses a system wherein during a transaction process, the periphery device 100 indicates if there is a manufacturer instant rebate for any product currently in the customer's order. In the affirmative, the system or rebate system allows the customer to instantly receive credit for the rebate, while quickly and efficiently supplying the manufacturer with transaction data including both the demographic data and stimulation power the rebate is intended to provide in the first place, wherein the demographic data are used to further measure the effectiveness of the system and to further distribute rebates to the identified user or customer of the coupon card 1 (page 22: 21-24; page 27: 14-31).

Further, Fajkowski discloses that the coupon card (1) may include a customer's identification number, which allows the provider of the coupon card and/or manufacturer (supplier) to uniquely identify each individual user to whom a coupon card 1 is registered, thereby enabling purchase habits or behavior of each individual user to be extracted from



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collected sale data associated with each user and used by the supplier or manufacturer in further marketing analysis in order to prepare targeted coupon packages for the each individual user, wherein the targeted coupon packages are transmitted to each individual coupon card 1, to offer real-time rebates to a user or to increase/decrease a coupon value of a coupon already stored on an identified coupon card 1 in reaction to the user's response to a current promotion. Here, a clearinghouse 300 receives from a plurality of different POS periphery devices 100, linked to servers 200, related to different stores transaction data associated with the users identified by the coupon cards 1 and compiles a detailed database of the purchasing habits or behavior of all users of coupon cards 1. From this database, precise marketing profiles and reports can be provided to the manufacturer or supplier and used to generate customized coupon packages by the manufacturer or supplier for the benefit of the individual users of the coupon cards 1. In general, coupon data directed to a particular user of a coupon card 1 are transmitted from the manufacturer or supplier to the clearinghouse 300 (manager) to be uploaded by a periphery device 100, linked to the clearinghouse 300 via server 200, to the coupon card 1 during a transaction or redemption process at a retail establishment involving the identified coupon card 1 (See abstract; page 4: 24 to page 9: 7; page 19: 27 to page 20: 8; page 32: 11 to page 33: 6).

It is herein understood that the steps of notifying the clearinghouse 300 or manager of each of the coupons redeemed (discounts issued) by the retailers, notifying the manufacturers or suppliers of the transactions (purchase discounts issued by the retailers) involving their coupons distributed to the coupon card holders via the clearinghouse 300 or manager, paying the manager a service fee and reimbursing the retailers for honoring or redeeming the presented coupons are explicitly or implicitly supported in the current reference.

See figs. 7a-7b, 9 and 15c.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,380,991 to Valencia discloses a system for allowing a customer to obtain the benefits of reduced prices for certain items without the necessity of redeeming paper coupons. In fact, the manufacturer's coupons are electronically provided to the customer or shopper via a smart card having encoded in its memory a plurality of discount coupons redeemable on a plurality of products. Furthermore, the smart card stores information or sale data on products that have been purchased by the shopper (purchase behavior or purchase history). The coupons stored on the smart card are redeemed in a conventional manner at a retailer's POS and information, sale data and discount coupon data, stored on the smart card is updated accordingly (See abstract).

In general, at the retailer's POS or store, a tag is affixed to a discounted product displayed on the store shelf to thereby help the customer or the shopper identify a discounted product. The tag may contain other relevant product information and maybe color-coded. The tag could include several discount values associated with a particular product, thereby indicating that the customer or shopper would receive additional discounts if the particular product is repurchased in the future (one or more discounts applied to one particular product at different time intervals

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in the on-going or progressive couponing method). It should further be noted that, during a redemption process at the retailer's POS, product information, customer's identification and discount data are read from the smart card and if there is a match between a product currently in the customer's order and a product stored on the customer's smart card, then the discount related to this product is applied to the customer's order. And, if one or more products in the customer's order are subject to additional discounts or progressive discounts, then the system would scan the memory of the customer's smart card to determine whether the customer has previously purchased this particular item or product, listed in the progressive couponing. In the affirmative, the additional discounts are applied and the smart card memory is altered accordingly (multiple or progressive discounts are redeemed on the single product during a single shopping trip) (col. 2: 59 to col. 3: 52; col. 4: 37-51; col. 5: 31-42; col. 5: 55-61; **col. 6: 6-51**).

In another embodiment, the smart card storing the paperless or electronic coupons can be purchased from a customer service center or service provider. For instance, the smart card is purchased at a service center, the customer would pay a particular amount, such as \$ 25.00, for the card. In other words, the customer or purchaser pre-pays or loads the card with \$25.00 worth of coupons, used towards various discount coupons related to various products and the balance is adjusted accordingly and stored in the memory of the card following a redemption. In addition, and alternatively, as an inducement to purchase various items, the amount initially credited or stored on the smart card could be complimentary to the customer (that is to say that the smart card storing the initial monetary value could be given free to the customer as an incentive to buy a plurality of products associated with the plurality of discount values related to the initial monetary amount credited or stored on the card memory). When the customer

purchases the smart card 2 at the customer service center 64, all the necessary information including the customer's identification number will be entered onto the smart card erasable memory. Additional monetary values, purchased by the customer or given free to the customer by the manufacturer or supplier, would be added to the smart card 2 memory when the original amount has been depleted (col. 6: 51 to col. 7: 12).

Finally, transaction data, associated with the electronic coupon redemption process, are collected at the participating retailers and forwarded to the respective manufacturers and used for tracking and paying the participating retailers for redeeming or honoring the electronic coupons presented by the users of the re-usable smart card (col. 9: 3- 29).

**US Patent 6,385,591B1 to Mankoff** teaches a system for distributing electronic coupons to users over the Internet. A user selects a given link in a displayed web page, related to a server or first server, on a client machine or first computer, wherein the given link is an image embedded in an advertising banner displayed on the web page such that a user click-through on the banner automatically generates an electronic coupon or virtual coupon, which is downloaded by the user from the first server and saved on a local database or memory on the client machine or first computer. Thereafter, following this recording or saving, the electronic coupon (coupon information) is retrieved and transferred to a handheld device or PDA, having a memory means or database file to store the transferred coupon information, via a communication interface when the PDA is synchronized to the client machine. The user can then take the PDA to a local store POS terminal or second computer, where the coupon information can be retrieved from the memory of the PDA during a redemption process when

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the required product is bought. Further, the operator of the first server may provide the coupon distributions service for a fee. Finally, the retail store where the coupon was redeemed receives appropriate compensation, for honoring the coupon submitted by the user via his PDA, from the advertiser (manufacturer or retailer) who provides the coupon (See abstract; col. 1: 11-16; col. 1: 44 to col. 2: 34; col. 3: 50-67; col. 4: 18-67; col. 5: 7-11; col. 5: 27-53.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ  
01/22/05

Jean D. Janvier  
Patent Examiner

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**JEAN D. JANVIER**  
**PRIMARY EXAMINER**

*Janner Jean Dario*